

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#11

In Re Application of:
Joseph Honein

Serial No.: 10/035,998

Filed: 12/26/2001

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Atty. File: IM 1725 CIP

Group Art Unit: 3634

Examiner: A. Chin-Shue

FOR: Composite Scaffolding Plank and Method of Forming Same

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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OFFICE OF PETITIONS

TRANSMITTAL OF APPEAL BRIEF

1. Transmitted herewith in triplicate is the APPEAL BRIEF in this application with respect to the Notice of Appeal.

2. STATUS OF APPLICANT

This application is on behalf of
☐ other than a small entity
☒ small entity

3. ☐ Applicant hereby petitions for an extension of time of (1) month for filing the Brief from the Notice of Appeal filed _____ as provided in 37 CFR 1.136 (a).
☐ a fee in the amount of \$
☐ is enclosed
☐ charge to Deposit Account No. 10-0740. (Duplicate notice enclosed.)
☐ fee previously paid

4. FEE FOR FILING APPEAL BRIEF

Pursuant to 37 CFR 1.17(f) the fee for filing the Appeal Brief is:

☒ small entity \$165.00
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Appeal Brief fee due \$165.00

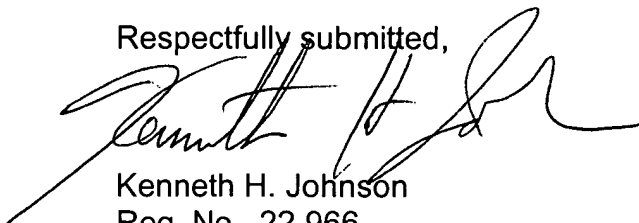
5. FEE PAYMENT

☒ Attached is a check in the sum of \$165.00

☐ If any additional fee is required, charge Acct. No. 10-0740.

This sheet is presented in duplicate.

Respectfully submitted,



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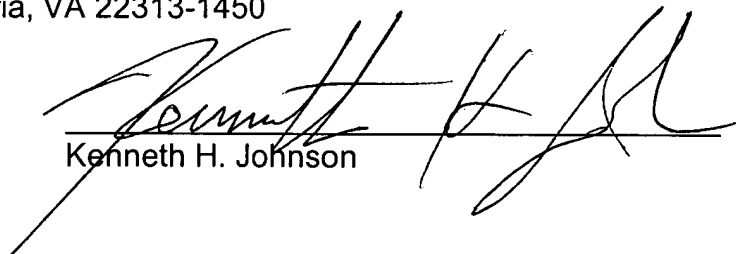
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Kenneth H. Johnson



THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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Examiner: A. CHIN SHUE

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For: COMPOSITE SCAFFOLDING PLANK AND METHOD OF FORMING SAME

BRIEF ON APPEAL

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I.

REAL PARTY IN INTEREST

The real party in interest is the inventor, Joseph HONEIN.

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IM 1725 CIP Brief

II.
RELATED APPEALS

There are no related appeals or interferences of applicant, Joseph HONEIN, known to appellant or appellant's legal representative which will directly or indirectly affect or be affected by or have a bearing on the Board's decision in this appeal.

III.
STATUS OF CLAIMS

Claims 1-13 and 16 remained in the application. All of the claims are rejected.

IV.
STATUS OF AMENDMENTS

All amendments have been entered of record.

V.
SUMMARY OF THE INVENTION

The present invention is a composite scaffolding plank made from two or more wooden boards by positioning the boards in side by side parallel abutment and embedding a plurality of spaced pins transversely through the boards and to increase the strength of a wooden plank by cutting the plank longitudinally, positioning the resulting sections in side by side parallel abutment with the wood grains in alternating directions and embedding a plurality of spaced pins in the sections (spec., page 7, ln. 6-15 and Fig. 2).

The boards are compressed laterally by an external force in the boring and pinning steps such that after the manufacture when the boards are no longer compressed by an external force used in the manufacturing process, the wooden boards are held together in compression by the helical pins and holds the boards in tight abutment. (spec. page 10, ln. 5-14).

Preferably each board has a fiber bending value of at least 2200 psi, a modulus of

elasticity in the range of 1.6×10^6 to 1.8×10^6 . (spec. page 19, ln. 7-9).

VI. ISSUES

ISSUE 1. IS CLAIM 16 ANTICIPATED UNDER 35 USC 102 ANGUERA '191?

ISSUE 2. ARE CLAIMS 1-13 AND 16 OBVIOUS OVER LARSEN OR LARSEN IN VIEW OF WEBSTER UNDER 35 USC 103(a)?

ISSUE 3. IS CLAIM 16 OBVIOUS OVER LARSEN OR WEBSTER IN VIEW OF ANGUERA '191 OR ANGUERA '191 ALONE UNDER 35 USC 103(a)?

VII. GROUPING OF CLAIMS

For the purposes of appeal the claims are grouped together.

VIII. ARGUMENT

A. THE REJECTION

Claim 16 stands rejected as anticipated by Anguera under 35 USC 102(b) or unpatentable over Anguera '191 under 35 USC 103(a).

Claims 1-13 and 16 stand rejected under 35 USC § 103(a) as being unpatentable over Larson or Larson in view of Webster.

Claim 16 stands rejected under 35 USC § 103(a) as being unpatentable over Larson or Webster in view of Anguera '191.

B THE PRIOR ART

ANGUERA '191

Anguera '191 combines green wood strips of varying length disposed in an upright position in a row with other green strips, thus describing the wood grain of each strip being aligned in the same direction for each strip (plank). Anguera '191 clamps the boards drills

a bore, moves the work piece and inserts a pin into a previously drilled hole. Anguera '191 uses pins with a square cross section and spiral threads.

LARSEN

Larsen discloses a scaffolding with two adjacent planks having a pin extending there through the plank. According to the translation, "the surface elements comprise multiple planks arranged side by side and penetrated and held together by a transverse connecting iron at each end of the element" (page 2, third paragraph). No information is provided on the process of attaching the elements together. However, since the walkway is to be "assembled easily and quickly", the pins are loosely fitted into the boreholes, so they can be removed and the system assembled elsewhere. This disclosure has no suggestion to any aspect of the present invention and is of only interest as "state of the art". The examiners' assertion that by binding the boards together the boards are held in compression, is totally unsupported by any disclosure in the reference. There is no art of record which would indicate that a pin (nail) driven into a board to bind the boards together places the boards in a compressed relationship. In order to obtain the compressed relationship recited in the present claims, the boards are compressed by the manufacturing machine, then pinned together while compressed. Larsen has the pins loosely fitted into the boreholes, so they can be removed and the system assembled elsewhere. This is the opposite from the present boards, which are made to permanently replace large single board scaffold planks.

The examiner is improperly using the application specification as a reference (Final page 5, lines 5-10), as to what applicant found to be suitable materials.

WEBSTER

Webster discloses the production of wooden panels by assembling the components in a jig with the side surfaces in side by side relationship, drilling to form bores through the components and threaded light metal dowels extended through the bores to attach the components together (col. 1 ln. 7-34). The crest of threads cut into the wood (col. 3, line 44-45) and draw the surfaces together (col. 1, ln. 54-58). The wood components are placed together prior to and during the process by "light press fit engagement," such as by a light band pressure (col. 3, lines 11-14). Webster discloses panels made of thin elements held together by a rod. The Webster panels are placed together then drilled and the soft threaded rod inserted after the removal of the drill bit.

C. THE ISSUES

ISSUE 1. IS CLAIM 16 ANTICIPATED UNDER 35 USC 102 ANGUERA '191?

The rejection is deficient since it fails to point out that portion or portions of the reference relied on by the mere conclusion "being clearly anticipated". However at no point in Anguera '191 are the wooden boards taught to have either a fiber bending value of at least 2200 psi or a modulus of elasticity in the range of 1.6×10^6 to 1.8×10^6 .

Rejections under Section 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. See *In re Arkley, et al.*, 172 USPQ 524, 526 (CCPA 1972). Further the test that determines whether the reference is anticipatory or not is whether the reference contains an enabling disclosure. *In re Hoeksema*, 158 USPQ 596 (CCPA 1968). A rejection under 35 USC 102 for anticipation necessarily implies that the invention sought be patented is not new, i.e., that there are no differences between what is claimed and what is disclosed in the prior art. See *In re Kalm*, 154 USPQ 10 (CCPA 1967). Accidental or unwitting duplication of an invention cannot constitute an

anticipation that anticipation under 35 USC 102. *In re Felton*, 179 USPQ 295 (CCPA 1973). The naming of compounds by a reference does not constitute a description of the invention within the meaning of 35 USC 102(b), but is nothing more than a speculation about their potential or theoretical existence. *In re Wiggins, et al.*, 179 USPQ 421 (CCPA 1973). To sustain a rejection pursuant to 35 U.S.C. §102 each reference individually must identically disclose all the elements of the claim sought to be rejected. See *Kahman v. Kimberly - Clark Corp.* 218 USPQ 781 (Fed. Cir. 1984) and *Leinoff v. Louis Milona & Sons, Inc.* 220 USPQ 845 (Fed. Cir. 1984).

This rejection must fail, since the reference fails to mean any standard of statute, regulation or law.

ISSUE 2. ARE CLAIMS 1-13 AND 16 OBVIOUS OVER LARSEN OR LARSEN IN VIEW OF WEBSTER UNDER 35 USC 103(a)?

Larsen alone

In regard to claims 1-13 Larsen discloses planks held together by U clamps and notes that in the prior art it was known that planks arranged side by side could be penetrated and held together by a transverse metal rod at the ends. Larsen shows a scaffolding with two adjacent planks having a pin 5 extending there through the plank. According to translation, "the surface elements comprise multiple planks arranged side by side and penetrated and held together by a transverse connecting iron at each end of the element" (page 2, third paragraph). No information is provided on the process of attaching the elements together other than the pins 5 are driven through holes 7. The Larsen disclosure is the use of the U shaped clamp which drops over a rod 5 in each of two abutting elements and over a cross member 12. Driving the pin 5 through a hole 7 is not

a suggestion or disclosure to place the pin in the boards under compression as recited in the present claims.

The examiner has failed to make out a *prima facie* case of obviousness here, additionally because he has used a legal conclusion as evidence. Inventions are obvious over references and the examiner has not cited any reference to support his legal conclusion of "to enhance the integrity" regarding the use of more pins than just the two used by Larsen, "conventional practice" regarding alternating wood grain¹ and, "obvious mechanical expedient" regarding the plank dimensions and wood properties. (See *In re Bezombes*, 164 USPQ 387, 391 (CCPA 1970). This resort to a cliched extension of the knowledge of one of ordinary skill in the art in the face of the total absence, even in non analogous art, to include the invention does not represent a proper basis for maintenance of the rejection of the present claims. Begging the issue by a term such as ""obvious mechanical expedient" does not apprise applicant of the basis of the rejection. It may be an "obvious mechanical expedient" or similar connotation but how can this make it less of an invention. (*In re Bezombes, et al., supra*). Most inventions are "obvious mechanical expedients" arranged in a non obvious manner.

The fact that Larsen is silent on these points cannot be used as evidence to draw any conclusion. Silence in a reference is not a proper substitute for an adequate disclosure of facts. *In re Burt*, 148 USPQ 548 (CCPA 1966). "Much confused thinking could be avoided by realizing that rejections are based on statutory provisions, not on references, and that the references merely supply the evidence of lack of novelty,

¹ In the context of the present invention there is no suggestion in the art that alternation the direction of the grain is desirable.

obviousness, loss of right or whatever may be the ground of rejection." *In re Hilmer, et al.*, 149 USPQ 480, 490 (CCPA).

Larsen in view of Webster

Contrary to the examiners assertion Larsen only shows a plurality of planks. it does not show or suggest any of the other limitations of the claims. Other than the further resort to the baseless legal conclusions as "obvious mechanical expedient" "conventional practice" does not apprise applicant of the basis of the rejection (*In re Bezombes, et al., supra*) no evidence from Webster is provided to support the conclusions. Again these rejection fail to meet all minimum requirements of evidence, notice as required by the law and the rejection must fail.

ISSUE 3. IS CLAIM 16 OBVIOUS OVER LARSEN OR WEBSTER IN VIEW
OF ANGUERA '191 OR ANGUERA '191 ALONE
UNDER 35 USC 103(a)?

Larsen in view of Anguera '191

Larsen has no suggestion to any aspect of the present invention and is of only interest as "state of the art". Relevant to the present claims, Anguera '191 uses pins with a square cross section and spiral threads to pin the boards together, other than that none of the other limitations of the present claims are disclosed or suggested by the proposed combination. Larsen is making boards which are the opposite from the present boards, which are made for permanent binding under compression to replace large single board scaffold planks. A claim invention which involves doing what the reference tries to avoid is the very antithesis of obviousness. *In re Buehler*, 185 USPQ 781(CCPA 1975).

Webster in view of Anguera '191

Webster discloses the production of wooden panels by assembling the components in a jig with the side surfaces in side by side relationship, drilling to form bores through the components and threaded light metal dowels extended through the bores to attach the components together. Relevant to the present claims, Anguera '191 uses pins with a square cross section and spiral threads to pin the boards together, other than that none of the other limitations of the present claims are disclosed or suggested by the proposed combination. Applicant incorporates the previous comments regarding the inadequacy of the prior art and the combinations of art..

D. Conclusion

The claims as limited to the preferred wood (spec. page 19, lines 8-9), which define the preferred plank contemplated, is not suggested by any reference of record. There is no motivation or suggestion to make the combination of art proposed for either of two claim groupings.

There is no *per se* rule of obviousness that eliminates the need for fact-specific analysis of claims and the prior art and that the use of such a rule must stop. See *In re Ochiai*, 37 USPQ2d 1127, 1132 (Fed. Cir. 1996). The examiner is not applying the prior art to the claims because there is no disclosure of the specific limitations, but is rather using silence as evidence. The examiner's bare statement that steps are "obvious mechanical expedients" is completely unsupported by any evidence and therefore has no weight. The examiner has failed to make out a *prima facie* case of obviousness because he has used a legal conclusion as evidence. Inventions are obvious over references and

the examiner has not cited any reference to support his legal conclusions.

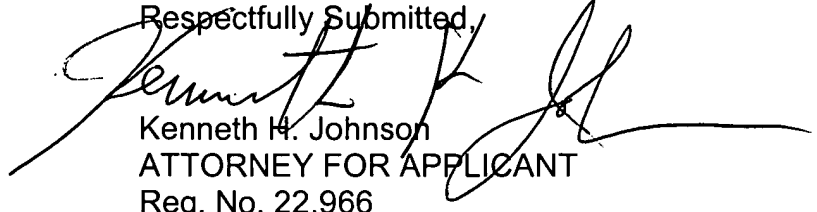
Rejections based on §103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner has the initial duty of supplying the factual basis for the rejection. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis. See *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967). Even if the teachings of references can be combined as suggested by the examiner, there is no factual basis from which to conclude that the process resulting from the combined teachings would include the combination of elements of appellant's invention.

A determination of obviousness must involve more than indiscriminately combining prior art; a motivation or suggestion to combine the art must exist. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.* 221 USPQ 929,933 (Fed. Cir. 1984). Such a suggestion may come from the references themselves, from references and disclosures in references known to be of importance in the particular field, and from the nature of the problem, leading inventors to look to references to possible solutions for the problem. *Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc.*, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996). In the present situation the record contains no evidence of a motivation (the mere assertion by the examiner that it would be obvious to make the combination not being one of the enumerated methods to present such evidence).

The present invention can be achieved only by fallacious inductive reasoning to combine the cited references.

It requested that the final rejection be reversed.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'Kenneth H. Johnson', written over the typed name and title.

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IX.

APPENDIX

A. CLAIMS ON APPEAL

1. A composite scaffolding plank comprising:

a plurality of wooden boards each having a fiber bending value of at least 2200 psi, a modulus of elasticity in the range of 1.6×10^6 to 1.8×10^6 , a lengthwise direction, two opposing sides being flat and extending parallel to said lengthwise direction, each of said sides having a height, said height being the smallest dimension of said wooden boards;

said plurality of wooden boards positioned in side to side parallel abutment;

at least three bores extending through said plurality of wooden boards in a first direction;

at least three spaced helical pins extending transversely in a second direction opposite to said first direction through and imbedded in said bores in said plurality of wooden boards, said plurality of wooden boards being under compression, normal to said wooden board sides and normal to said lengthwise direction; and

said plurality of wooden boards being held together in compression by said helical pins.

2. A composite scaffolding plank as in claim 1 wherein said plurality of wooden boards comprise three of said wooden boards.

3. A composite scaffolding plank as in claim 1 wherein:

each of said plurality of wooden boards having a length and including a top and two opposing ends;

said wooden board tops being co-planar;

said wooden board lengths being substantially equal; and

said wooden board ends forming a substantially continuous surface.

4. A composite scaffolding plank as in claim 1 further comprising:

said plurality of wooden boards having a transverse bore extending substantially therethrough for each of said helical pins;

so that said transverse bore facilitates placement of said corresponding helical pin in said

plurality of wooden boards.

5. A composite scaffolding plank as in claim 1, wherein each of said at least three spaced helical pins has a square cross section.

6. A composite scaffolding plank as in claim 2, wherein said three wooden boards comprise a middle board and two outer boards;

said three wooden boards each having a wood grain direction; wherein

said middle board is oriented such that the direction of said wood grain of said middle board alternates against said wood grain direction of said two outer boards.

7. A composite scaffolding plank comprising:

a plurality of wooden boards;

each said wooden board having a fiber bending value of at least 2200 psi, a modulus of elasticity in the range of 1.6×10^6 to 1.8×10^6 and a rectangular prism shape;

each said wooden board having a length, a first end surface, a second end surface, a top surface, a bottom surface, and two opposing side surfaces;

each said side surface being narrower than said top surface, said top surface having a width equal to a width of said bottom surface;

said plurality of wooden boards positioned with at least one of said side surfaces of each said wooden board in parallel abutment to at least one side surface of another said wooden board;

said top surfaces of said wooden boards being co-planar;

at least three bores extending through said plurality of wooden boards in a first direction;

at least three spaced helical pins extending transversely in a second direction opposite to said first direction through and imbedded in said bores in said plurality of wooden boards, normal to said opposing side surfaces; and

said plurality of wooden boards being held together in compression by said helical pins.

8. A composite scaffolding plank as in claim 7, further comprising:

all said first end surfaces of said plurality of wooden boards being co-planar; and

all said second end surfaces of said plurality of wooden boards being co-planar.

9. A composite scaffolding plank as in claim 8, wherein said plank has a nominal height of 2" and a combined nominal width of 10".

10. A composite scaffolding plank as in claim 9 wherein said plurality of wooden boards comprise a first wooden board, a second wooden board and a third wooden board.

11. A composite scaffolding plank as in claim 10, wherein:

said top surface and said bottom surface of said first wooden board have a nominal width of 4";

said top surface and said bottom surface of said second wooden board have a nominal width of 3";

said top surface and said bottom surface of said third wooden board have a nominal width of 4";

said opposing side surfaces of said first wooden board have a nominal height of 2";

said opposing side surfaces of said second wooden board have a nominal height of 2"; and

said opposing side surfaces of said third wooden board have a nominal height of 2".

12. A composite scaffolding plank as in claim 7, wherein all said lengths of said plurality of wooden boards are approximately equal.

13. A composite scaffolding plank as in claim 7, wherein said plurality of wooden boards comprises a middle board and two outer boards;

said plurality of wooden boards each having a wood grain direction; wherein

said middle board is oriented such that the direction of said wood grain of said

middle board alternates against said wood grain direction of said two outer boards.

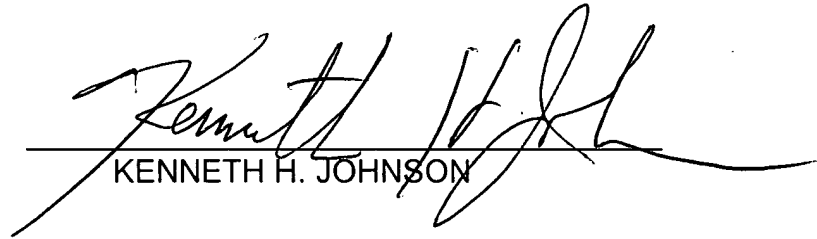
16. A composite scaffolding plank comprising a plurality of wooden boards held together in compression by a plurality of helical pins, each of said pins having a square cross section, each said wooden board having a fiber bending value of at least 2200 psi and a modulus of elasticity in the range of 1.6×10^6 to 1.8×10^6 .

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